



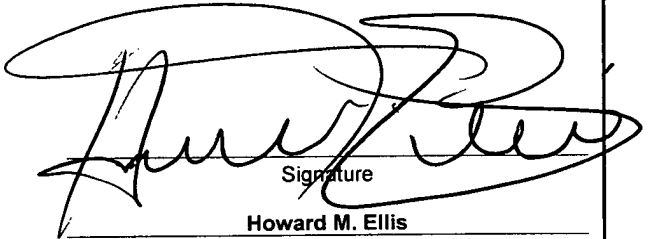
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/733,628	12/11/2003
		First Named Inventor	
		Russell BONAVENTURA et al.	
		Art Unit	Examiner
		2872	Arnel C. Lavarias
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>25,856</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p> Signature</p> <p><u>Howard M. Ellis</u> Typed or printed name</p> <p><u>716-626-1564</u> Telephone number</p> <p><u>February 6, 2006</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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U.S. Patent Application No.: 10/733,628  
Attorney Docket No.: LEAP:127 US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Russell Bonaventura et al.

Application No.: 10/733,628

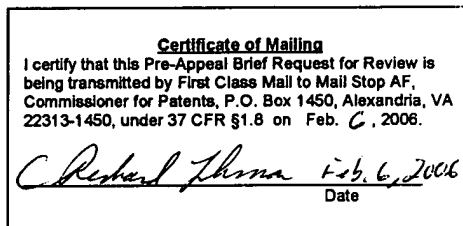
Filed: 12/11/2003

Examiner: Arnel C. Lavarias

Group Art Unit: 2872

Confirmation No. 1669

For: MICROSCOPE STAGE CONTRASTING MEANS



**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

This brief is in support of Applicant's Pre-Appeal Conference (Pilot Program). Applicant has filed a Notice of Appeal concurrently with this brief and Pre-Appeal Brief Request for Review.

**Status of Application:**

Claims 1-6, 9-15 and 17-20 are pending in this application, and have been finally rejected. No claims have been allowed.

In response to the rejection made Final in the Office Action of November 8, 2005, Applicant filed a Request for Reconsideration on January 3, 2006. An Advisory Action of January 13, 2006, indicated Applicant's response was not persuasive.

**THE CLAIMED INVENTION**

The invention relates to a microscope stage (See Fig. 1 (#24) of drawings) which provides desired contrast between the specimen (not illustrated) for viewing, and the microscope stage, allowing the user to more easily view and orient (maneuver) the specimen on the microscope stage before insertion into the optical path of the microscope.

This is accomplished by means of a first embodiment of the invention illustrated by Figs. 2-3

(Claim 1) Recites a microscope stage having an upper stage surface (i) with a recess (ii) wherein the upper stage surface (i) has a first background color (iii). The upper stage recess (ii) is filled with a removable, non-transparent stage insert (iv) that is complementary to the upper stage recess (ii) and the removable, non-transparent stage

insert (iv) possesses a color (vi) which is different than the first background color (iii) of the upper stage surface (i).

An alternative, second embodiment of the invention:

(Claim 9) Recites a microscope stage (See Fig. 1 (#24) of drawings) comprising an upper stage having a first color (i) , a non-transparent contrasting stage insert comprising a second color (ii) and a portion of the color of the first color (i) of the upper stage.

Claim 17 recites the invention in an alternative format as a device:

(Claim 17) Recites a device, instead of a microscope stage. The device provides for contrast between a microscope stage and a specimen comprising a microscope stage (i), comprising a non-transparent contrasting stage insert (ii) having a first color (iii), a specimen having a second color, wherein the first color of the stage insert is different than the second color of the specimen.

### THE REJECTIONS

All claims (claims 1-6, 9-15 and 17-20) stand rejected for reasons of obviousness under 35 U.S.C. 103(a) over Douglas-Hamilton et al (US Pat. 5,306,467) in view of Kapitza et al (US Pat. 5,781,338). In addition, Fischer et al (US Pat. 4,436,385) and Sattler (US Pat. 4,906,083) were cited in the rejections at paragraphs 13 and 14 of the final Office Action in a secondary supporting capacity (along with Douglas-Hamilton et al). **However, Douglas-Hamilton et al (US Pat. 5,306,467) was cited as the primary reference and relied on in all grounds of rejection.**

### FINAL OFFICE ACTION & ADVISORY ACTION

The final Office Action of 11/8/05 and the Advisory Action of 1/13/06, urge the following main points with respect to the primary reference, Douglas-Hamilton et al and the secondary reference to Kapitza et al (US Pat. 5,781,338):

- (i) Applicant's claims effectively read-on the structural features of the device of Douglas-Hamilton et al, except for the "upper stage comprising a first color", which the Examiner expressly acknowledges, is not taught by Douglas-Hamilton et al ;
- (ii) However, the above shortcoming in Douglas-Hamilton et al is allegedly off-set by Kapitza et al, who teach this feature, and therefore, would be obvious *ipso facto* to introduce into the "upper stage" of the microscope stage of Douglas-Hamilton et al a first color according to Kapitza et al., as to arrive at Applicant's claimed invention, and
- (iii) Unless structurally distinguishable over the prior art, the preamble of Applicant's claims, as in the immediate case, would not be given "significant patentable weight" over the prior art.

### DOUGLAS-HAMILTON ET AL (US Pat. 5,306,467)

The structural features of the slide loading apparatus of Douglas-Hamilton et al include a slide holder (10) with a recess (14) extending across the diameter of the slide holder. The recess is dimensionally sufficient to accommodate a slide (21) which is seated in the bed of the recess (14). A generally U-shaped holder clamm (20) constructed

from magnetically susceptible metal is pivotally mounted to the slide holder (10) and performs as a retainer for the slide (21) seated in recess (14). The U-shaped holder clamp (20) engages a coverslip (25) locking it against a rim (23) and slide (21) seated in recess (14). A set of spaced bar magnets (28) on the bottom side of slide holder 10 (See Figs. 1 & 3) generate magnetic force through the slide, attracting the metal U-shaped holder clamp (20) in order to generate uniform pressure on the coverslip (25) to force excess sample fluid from the defined volume between the coverslip (25) and slide (21) for maintaining a constant separation distance between the slide (21) and coverslip (25).

It is also believed to be significant that Douglas-Hamilton et al fail to expressly teach/identify the composition of matter, and particularly, the color of slide holder (10) which the final Office Action seems to identify as the equivalent of Applicant's "upper stage comprising a first color."

#### APPLICANT'S RESPONSE

(i) Douglas-Hamilton et al do not expressly teach or suggest their device is a microscope stage, but instead disclose their device as a slide loading apparatus (Fig. 1) for use in automated cell counting systems or standard optical microscopes for measuring the number of cells in a fluid biological sample. The Advisory Action erred in failing to accord weight to Applicant's preamble which expressly recites: "A microscope stage..." According to the Advisory Action such preamble is not given significant patentable weight unless structurally distinguishable. The failure to accord patentable weight to Applicant's preamble therefore contradicts the Examiner's own admission. The Examiner acknowledges Douglas-Hamilton et al is not a full anticipation of the rejected claims at the bottom of page 3 of the Final Office Action wherein he states: **Douglas-Hamilton et al do not explicitly disclose the upper stage comprising a first color**, as required by the rejected claims. Because Applicant's claimed device is structurally distinguishable over Douglas-Hamilton et al the failure to accord weight to the finally rejected claims reciting a "microscope stage" in the preamble was a substantial reversible error.

(ii) Also, Douglas-Hamilton et al do not illustrate a microscope in their drawings, but do disclose in col. 5, lines 7-15 that their slide loading device is more conducive for use with manual microscopy, and states there: "it becomes more important that the specimen is as close to the microscope condenser as possible in order to maintain the use of the full range of available illumination optics; Hence, the slide loading device of Douglas-Hamilton et al is not taught to be a microscope stage, or that it can be used in place of a microscope stage. Instead, the reference suggests vis-à-vis "microscope condenser" at Col. 5, that the prior art device is actually used by placement onto the stage of a microscope.

In arriving at a conclusion of obviousness, one is required to view the prior art taken as a whole. Applicant queries: if the device of Douglas-Hamilton is placed onto the stage of a microscope, how could the device of the prior art be properly viewed as a "microscope stage", like that of the rejected claims?

(iii) The Examiner's representation that Douglas-Hamilton et al disclose the structural features by essentially reading on Applicant's claims is incorrect. The allegation that

Douglas-Hamilton et al teach an “upper stage” 10, where a specimen slide is normally mounted, is incorrect. Instead, slide 21, according to Douglas-Hamilton et al, is seated below the surface of the upper stage in recess 14. Hence, even if Douglas-Hamilton et al had identified an upper surface having a “first color” for the “upper stage”, which it does not, the slide positioned in recess 14 would not be in a position to benefit from the contrasting colors between the first color on the surface of the device and the second contrasting color of holder-clamp 20 embedded in recess (14) where it functions as a clamp for retaining the slide under pressure.

(v) Furthermore, holder clamp 20 of Douglas-Hamilton et al is not a contrasting stage insert according to Applicant’s claim 1. According to Douglas-Hamilton et al holder clamp 20 is a U-shaped retainer clamp pivotally mounted to the slide holder and designed to apply pressure to the cover slip and slide. Structurally, the U-shaped retainer clamp (20) of Douglas-Hamilton et al does not meet the criteria for a non-transparent contrasting stage insert that is “complementary” with the recess, according to Applicant’s claim 1, etc.

(vi) Page 3 of Applicant’s Request for Reconsideration filed 1/3/06, urges that during prosecution before the Office, claims are given their broadest reasonable interpretation consistent with the specification and the prior art. Compare *In re Finsterwalder*, 58 CCPA 871, 436 F. 2d 1028, 168 USPQ 530 (CCPA 1971). Also see *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir.1983). Note, the operative word in the above stated rule of law is “reasonable”. The slide loading apparatus of Douglas-Hamilton et al for measuring the number of cells in a fluid biological sample bears no structural resemblance with Applicant’s claimed “microscope stage” for creating a contrast with a specimen according to Applicant’s invention, so that the specimen can be more easily viewed prior to insertion into the optical path. The explanation of claim language by the Examiner must bear some rational connection to the way the language is employed in Applicants’ specification, or to the meaning it would be given by a person of ordinary skill in the subject art. See, for example, *In re Gordon* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) The fact that Douglas-Hamilton et al teach a slide loading apparatus which can be placed onto the stage of a microscope, and includes a U-shaped holder clamp which enters a recess in the slide holder for holding the slide/specimen in place seated in the recess, has no bearing on the structural features of Applicant’s device, utility and objective of enabling a user to orient a specimen on a stage. Simply put, the device of Douglas-Hamilton et al has no relevance to Applicant’s microscope stage, etc.

(vii) The Examiner’s explanations of the rejections wherein multiple references are combined in order to arrive at Applicant’s claimed invention, such as in the earlier grounds of rejection citing Douglas-Hamilton et al in view of Kapitza et al; the rejection of claim 6 over Douglas-Hamilton et al in view of Kapitza et al and further in view of Fischer et al (US Pat. 4,436,385); the rejection of claims 17-20 over Douglas-Hamilton et al in view of Sattler et al (US Pat. 4,906,083), provide no rational basis for combining the references. The recognized law for combining references to support the

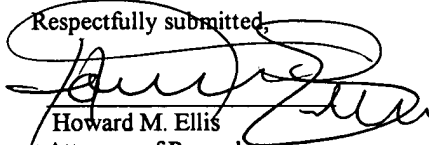
conclusion that the claimed combination of structural features is directed to obvious subject matter requires that either the references expressly or impliedly teach or suggest the claimed combination, or the Examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references. See, for Example, *Ex parte Clapp* 227 USPQ 972 (973) (PTO Br Pat. App. & Int. 1985); *In re Geiger* 2 USPQ2d 1276 (CA, Fed. Cir. 1987) In this regard, the Final Office Action of 11/8/05, bottom of page 3 and the top of page 4 mentions Kapitza et al disclosure of an upper microscope stage having a first color (black) with a recess therein. And, then immediately concludes it would be obvious to one of ordinary skill in the art to modify the upper stage of the slide loading apparatus for measuring the number of cells in a fluid biological specimen of Douglas-Hamilton et al by following the teachings of Kapitza et al. Importantly, no rationale or explanation was provided in the final Office Action how the teachings of the two references, Douglas-Hamilton et al and Kapitza et al were selected and combined, nor has the Examiner provided a convincing line of reasoning providing a basis for combining Douglas-Hamilton et al and Kapitza et al independently of Applicant's own disclosures. Clearly, the combining of these references was based on hindsight from a prior reading of Applicants' own disclosure.

#### CONCLUSION

The rejections of claims 1-6, 9-15 and 17-20 under 35 U.S.C. 103(a) for reasons of obviousness rely on combinations of references. However, all grounds of rejection rely on at least Douglas-Hamilton et al as the primary reference. The rejections cannot stand because Douglas-Hamilton et al *inter-alia* is not a teaching reference of a microscope stage. When Douglas-Hamilton et al is combined with the secondary references, such as Kapitza et al, they still fail to make out a *prima facie* case of obviousness under Section 103. The Advisory Action indicates Applicant's claims reciting: "A microscope stage" in the preamble is not given significant patentable weight unless structurally distinguishable. However, the Examiner acknowledges Douglas-Hamilton et al is not a full anticipation of the rejected claims at the bottom of page 3 of the Final Office Action wherein he states: **Douglas-Hamilton et al does not explicitly disclose the upper stage comprising a first color, as required by the rejected claims.** Consequently, the failure to accord weight to the finally rejected claims reciting a "microscope stage" in the preamble was a substantial reversible error. Finally, for reasons outlined above, the disclosures of Douglas-Hamilton et al even when combined with the secondary references fail to teach the structural features recited by the rejected claims. Reversal of all grounds of rejection is courteously solicited.

Feb. 6, 2006

Respectfully submitted,

  
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